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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/735,816

12/16/2003

Jun Fujimoto

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LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON, DC 20005-3960

EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,816

Applicant(s)

FUJIMOTO, JUN

Examiner

Jamisia A. Plucinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 and 10-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claims 1, 10, 13, 18 and 22: the applicant states in the pre-amble of the claims that the invention is directed to a system. However, in the body of the claim language, the claims are positively reciting active method steps of detecting, transmitting, receiving, recording, and managing. In the claims, method-like limitations are allowed, if they are written in terms of being a descriptive of how the structure performs or functions. Instead, the newly amended claims, are positively claiming the steps of detecting, transmitting, receiving, recording and managing, therefore causing it to be unclear if this is a system claim or a method claim. The examiner suggests either using the terms “for” or “configured to perform the steps” or changing the active voice of the method limitations, i.e. changing “receiving” to “which receives”.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 and 10-24 are rejected under 35 U.S.C. 101 because they are directed to improper hybrid claims. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a system (ex. preamble of claims 1, 10, 13, 18 and 22) while the body of the claim positively recites the use of method claims of detecting, transmitting, receiving, recording and managing.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-18, and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Shore (6,225,906).

7. With respect to Claims 13 and 18: Shore discloses the use of a positional information management system comprising:

- a. A tag attached to an article and having a tag IC for storing a tag ID (Reference numeral 18 with corresponding detailed description);
 - b. A plurality of detectors each having a detector ID (Reference numeral 16 with corresponding detailed description) for detecting the tag ID via transmittance from the tag IC, the tag ID and the detector ID being transmitted (Column 6, lines 9-44);
 - c. Recording device for recording the tag ID, the detector ID and a time of detection (Reference numeral 42 with corresponding detailed description); and
 - d. Positional information management means (central monitoring system 16 with corresponding detailed description) containing the recording means, and for managing positional information of the article, base on the IDs and the time (See Figure 5A, for timestamp).
 - e. A terminal communicating with the positional information management device, wherein the information management device includes a search device searching for the position of the article based on the tag ID (Column 7, lines 1-41) or the name, input into the terminal (See Figures 5A and 6 with corresponding detailed descriptions as well as Column 12, lines 46-51).
8. Shore discloses the use of the system being used in a hospital, not a hotel. However it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994)

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9. With respect to Claims 14 and 20: See Figure 5A, with corresponding detailed description.
10. With respect to Claims 15 and 21: Shore discloses the detectors each have specific ranges in which each of the detectors detects the tag ID and the positional management system detects a movement state of the article, based on the specific ranges and the tag ID detected in the specific ranges (Column 5, lines 35-48).
11. With respect to Claims 16 and 22: Shore discloses the user is a patient of a hospital, which the examiner considers to be a customer of the hospital. As stated above, the system being in a hotel is considered to be intended use of the system and is not patentably distinct from the system with the same structural components. Shore discloses the positional information management system further comprises service management means such as when a patient is being transported for X-ray and the status of the transport (See Figure 3) which the examiner considers to be managing the service.
12. With respect to Claims 17 and 24: Shore discloses the positional information management system defines the area as a restricted area and manages security by generating an alarm or by setting a flag in the recording means when the article is in the restricted area (Column 2, lines 31-44 and Column 7, lines 10-41).
13. With respect to Claim 23: Shore discloses the positional information management means determines an area defined by at least one of the detector ID and determines whether or not the article is in the area based on the detector ID (Column 2, lines 3-17 and 36-44 and Column 5, lines 34-48).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1-5, 10-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shore (6,225,906).

17. With respect to Claim 1: Shore discloses the use of a positional information management system comprising:

f. A tag attached to an article and having a tag IC for storing a tag ID (Reference numeral 18 with corresponding detailed description);

g. A plurality of detectors each having a detector ID (Reference numeral 16 with corresponding detailed description) for detecting the tag ID via transmittance from the tag IC, the tag ID and the detector ID being transmitted (Column 6, lines 9-44);

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h. Recording device for recording the tag ID, the detector ID and a time of detection (Reference numeral 42 with corresponding detailed description); and

i. Positional information management means (central monitoring system 16 with corresponding detailed description) containing the recording means, and for managing positional information of the article, base on the IDs and the time (See Figure 5A, for timestamp).

18. Shore discloses the use of the system being used in a hospital, not a hotel. However it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994)

19. Shore discloses the use of a tag, which is attachable and detachable from a patient (upon discharge), however fails to disclose the tag has a detachable sticker, which the examiner considers to be for use of attachment.

20. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the tag include a detachable sticker, because Applicant has not disclosed how providing a detachable sticker provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any kind of attachment, either that of Shore, or of the detachable sticker because both attachment mechanisms perform the same function of attaching a tag to a user. Therefore, it would have been an obvious matter of design choice to modify Shore to obtain the invention as specified in Claim 1.

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21. With respect to Claim 2: Shore discloses the positional information management means records a relationship between the article and the tag ID and specifies the article based on the tag ID (Column 5, lines 35-48, Column 7, lines 42-61 and Column 8, lines 24-38).

22. With respect to Claims 3 and 19: Shore discloses the use of a tag, which is attachable and detachable from a patient (upon discharge), however fails to disclose the tag has a detachable sticker, which the examiner considers to be for use of attachment. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the tag include a detachable sticker, because Applicant has not disclosed how providing a detachable sticker provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any kind of attachment, either that of Shore, or of the detachable sticker because both attachment mechanisms perform the same function of attaching a tag to a user. Therefore, it would have been an obvious matter of design choice to modify Shore to obtain the invention as specified in Claims 3 and 19.

23. With respect to Claim 4: Shore discloses the positional information management means specifies a position and time of the article based on the detector ID, so as to obtain a movement history of the article (See Figure 5A, The system records a timestamp on when the tag was detected, and therefore considered to be a movement history).

24. With respect to Claim 5: Shore discloses the detectors each have specific ranges in which each of the detectors detects the tag ID and the positional management system detects a movement state of the article, based on the specific ranges and the tag ID detected in the specific ranges (Column 5, lines 35-48).

25. With respect to Claim 6: Shore discloses the positional information management means specifies the detector ID based on the tag ID of the article to specify a position of the article based on the detector ID (Column 5, lines 34-48).

26. With respect to Claim 7: Shore discloses the use of a terminal connected with the positional information management means for collecting Tag ID and transmit the positional information of the article to the terminal (Figures 5A, 6 and 8 disclose a user interface which is displayed on terminal 24).

27. With respect to Claim 8: The recording means records a relationship between a name of a user related to the article and the tag ID of the tag, and the positional information management means specifies the tag ID of the article based on the name of the user (See Figures 5A, 6 and 8 with corresponding detailed description).

28. With respect to Claim 9: Shore discloses a terminal connected with the positional information management means for collecting a name of the user and transmit the position information of the article to the terminal based on the name of the user (Figures 5A, 6 and 8 disclose a user interface which is displayed on terminal 24).

29. With respect to Claim 10: Shore discloses the user is a patient of a hospital, which the examiner considers to be a customer of the hospital. As stated above, the system being in a hotel is considered to be intended use of the system and is not patentably distinct from the system with the same structural components. Shore discloses the positional information management system further comprises service management means such as when a patient is being transported for X-ray and the status if the transport (See Figure 3) which the examiner considers to be managing the service.

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30. With respect to Claim 11: Shore discloses the positional information management means determines an area defined by at least one of the detector ID and determines whether or not the article is in the area based on the detector ID (Column 2, lines 3-17 and 36-44 and Column 5, lines 34-48).

31. With respect to Claim 12: Shore discloses the positional information management system defines the area as a restricted area and manages security by generating an alarm or by setting a flag in the recording means when the article is in the restricted area (Column 2, lines 31-44 and Column 7, lines 10-41).

Response to Arguments

32. Applicant's arguments filed 7/19/07 have been fully considered but they are not persuasive.

33. With respect to Applicant's argument that method limitations are allowed in a system claim: The applicant has stated that for decades U.S. patent applications have been prosecuted with method-like claim limitations and that seasoned examiners recognize these limitations not as "method-like" but as functional limitations. The application as also stated that there is no bases for objecting the form of these claims, and that the examiner is without authority to refuse to examine or give patentable weight to these limitations. As well as stated that the assertion that the claims incorporated subject matter in two different statutory classes of patentable subject matter is an example of a serious error propagating through the junior examining corps of the USPTO. First the examiner, would like to point out the arguments are moot in view of claims 7 and 9, and the subject matter has been added to newly added claims. However, the amendments

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to the independent claim 1, as well as the newly added claim limitations have caused more errors, as was discussed above, with mixing statutory classes. Method-like claims are allowed in a system claim, however as long as they are positively reciting the method is being actively performed. By claiming the active words such as detecting, transmitting, receiving, recording and managing, the claims are actively reciting the method steps are being performed, not just the functionality of them. Therefore the claims are encompassing both the method and the system, and therefore mixing statutory classes. With respect to applicant's argument that the examiner has no authority to refuse to examine or give patentable weight to these limitations: The examiner has not ignored these claim limitations and has given them patentable weight, and applied art to them in the non-final rejection, as well as given weight to the subject matter in the final rejection above. Rejection stands as stated above.

34. With respect to Applicant's argument with the Design Choice: the applicant has stated that a naked assertion that a difference between the invention and the prior art is an "obvious matter of design choice" is legally insufficient to reject the claim. The claim recites the use of the tag comprising a detachable sticker. The claim never recites the functionality of this sticker, or claims any use of the sticker. Therefore, as stated in the rejection, the detachable sticker is assumed to be used for attachment sake. Shore discloses the use of the attachment, such as the locking latch, therefore, replacing one known method of attachment with another is considered to be design choice, absent any stated advantage or purpose or teaching of solving a stated problem for attaching tags to item. The applicant has not pointed out this advantage or reasoning in the arguments, therefore the arguments are not considered to be persuasive and rejection stands as stated above.

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35. With respect to Applicant's argument that Shore does not disclose the use of a search function: As stated in the above rejection, Shore discloses the use of searching for a patient, who is to be transported and searching by name and tag, see rejection above for sections of the reference. The examiner does consider shore to disclose these limitations therefore rejection stands as stated above.

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

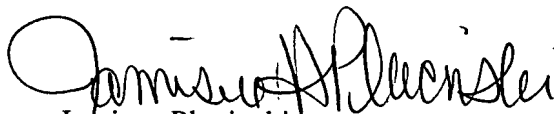
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jamisue Plucinski
Primary Examiner
Art Unit 3629